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UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/602,987	06/25/2003	Anthony J. Wasilewski	A-8919	6302

5642   7590   05/31/2007
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EXAMINER
CHAI, LONGBIT

ART UNIT	PAPER NUMBER
2131	

NOTIFICATION DATE	DELIVERY MODE
05/31/2007	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PTOmail@sciatl.com

	Application No.	Applicant(s)
Office Action Summary	10/602,987	WASILEWSKI ET AL.
	Examiner	Art Unit	
	Longbit Chai	2131	

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *14 March 2007*.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-19* is/are pending in the application.

   4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-19* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *25 June 2003* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

   Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

   Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

   a)☐ All   b)☐ Some *   c)☐ None of:

   1.☐ Certified copies of the priority documents have been received.

   2.☐ Certified copies of the priority documents have been received in Application No. _____.

   3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

   * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)
2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3)☐ Information Disclosure Statement(s) (PTO/SB/08)
   Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
   Paper No(s)/Mail Date. _____.
5)☐ Notice of Informal Patent Application
6)☐ Other: _____.

DETAILED ACTION

1.   Presently, pending claims are 1 – 19.

Continued Examination Under 37 CFR 1.114

2.   A request for continued examination under 37 CFR 1.114, including the fee set

forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this

application is eligible for continued examination under 37 CFR 1.114, and the fee set

forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action

has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on

3/14/2007 has been entered.

Response to Argument

3.   Applicant asserts that: "the instant application is a continuation-in-part of U.S.

Patent No. 5,742,677, which was filed April 3, 1995. Since this filing date of April 3,

1995, predates the issuance of the Wasilewski reference of May 23, 1995, the use of

the Wasilewski reference is improper under 35 U.S.C. 102(b) (Remarks: Page 7, 2nd

Para)". Examiner respectfully disagrees. The earliest filing date to support the

amended claim limitation, submitted on 10/30/2006, "selecting for encryption based on

an packet identifier" is the filing date of the Provisional application 60/054,575 that is

used by Applicants in the Affidavits, submitted on 3/14/2007, to overcome the 112, 1st

Paragraph of new matter rejection on Final Office action, submitted on 11/14/2006 by

the Examiner. Therefore, the earliest beneficial filing date for that particular amended

claim limitation is 1 August 1997, which is the filing date of the Provisional application

60/054,575. Accordingly, the earliest beneficial filing date to support that particular

amended claim limitation "selecting for encryption based on an packet identifier" is 1

August 1997 as admitted by Applicants in the Affidavits, submitted on 3/14/2007 (see

the rationale set forth as above) and as such Applicant's arguments are respectfully

traversed.

Information Disclosure Statement

The information disclosure statement filed on 12/06/2005 fails to comply with the

provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because the inventor (applicant)

name, application number, and some of the attorney docket numbers as indicated on

the IDS are incorrect.

It has been placed in the application file, but the information referred to therein

has not been considered as to the merits. Applicant is advised that the date of any re-

submission of any item of information contained in this information disclosure statement

or the submission of any missing element(s) will be the date of submission for purposes

of determining compliance with the requirements based on the time of filing the

statement, including all certification requirements for statements under 37 CFR 1.97(e).

See MPEP § 609.05(a).

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1 and 13 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 13 of copending Application No. 10/602,986. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1 and 13 of the instant application are envisioned by the claims of copending application that contain all the limitations of claims of the instant application because *the claim limitation of "the*

partially-encrypted bit stream" as recited in the instant application is equivalent to *that of*

"the combined bit stream" as presented in the co-pending application and as such are

unpatentable for obvious-type double patenting.

This is a <u>provisional</u> obviousness-type double patenting rejection because the

conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraph of 35 U.S.C. 102 that

forms the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4.   Claims 1 – 19 are rejected under 35 U.S.C. 102(b) as being anticipated by

Wasilewski (U.S. Patent 5,418,782).

As per claim 1, Wasilewski teaches a method for providing a plurality of

programs in a conditional access system (Wasilewski: Figure 1 and Column 1 Line 44 –

52), the method comprising the steps of:

selecting for encryption a plurality of digital bit streams from a transport stream,

the selecting performed using an identifier (Wasilewski: Figure 1 and Column 4 Line 65

– Column 5 Line 7 and Column 13 Line 65 – Column 14 Line 5: (a) one or more bit

streams of audio, video and data streams can be selected for encryption and besides,

(b) each type of audio, video and data streams is <u>uniquely</u> assigned a packet ID (PID)

and as such Wasilewski does teach selecting for encryption a digital bit stream from a

plurality of digital bit streams using an identifier – at least this prior-art rejection **is**

consistent with the disclosure of the original specification (i.e. <u>Provisional 60/054,578:</u>

<u>Page 28 Line 25-28 & SPEC: Page 27 Line 19 – 29</u>) that indicates "A subcategory of

information can thus be identified by the PID of its packets. As shown at output packets

707, the output from MUX704 is a sequence of individual packets from the various

subcategories. <u>Any part or all of MPEG-2 transport stream 701 may be encrypted</u>");

encrypting a portion of each of the plurality of digital bit streams (Wasilewski:

Column 4 Line 65 – 67: one or more service components of a given basic service can

be encrypted prior to transmission – i.e. partially encrypted);

combining the encrypted portion and the unencrypted portion with the transport

stream (Wasilewski: Column 5 Line 1 – 7 and Column 4 Line 65 – 67: multiplexing is

equivalent to combining); and

transmitting the combined stream (Wasilewski: Column 6 Line 17 – 20).

As per claim 13, Wasilewski teaches a method for providing a plurality of

programs in a conditional access system (Wasilewski: Figure 1 and Column 1 Line 44 –

52), the method comprising the steps of:

selecting a plurality of elementary bit streams from a plurality of programs

(Wasilewski: Column 4 Line 58 – Column 5 Line 7 and Column 13 Line 57 – Column 14

Line 16: service components, such as video (V), audio (A), and closed-captioning (i.e.

CC – data) are considered as a plurality of programs);

encrypting a portion of the selected streams (Wasilewski: Column 4 Line 65 – 67:

one or more service components of a given basic service can be encrypted prior to

transmission – i.e. partially encrypted);

combining the encrypted portion and the remaining portion of the selected

streams with the plurality of programs to provide a partially-encrypted stream

(Wasilewski: Column 5 Line 1 – 7 and Column 4 Line 65 – 67: multiplexing is equivalent

to combining); and

transmitting the partially-encrypted stream (Wasilewski: Column 6 Line 17 – 20).

As per claim 2 and 14, Wasilewski teaches each of the plurality of digital bit

streams includes a packet identifier, and wherein the selecting step selects each of the

plurality of digital bit streams by identifying a predetermined packet identifier

(Wasilewski: Column 13 Line 65 – Column 14 Line 5 and Column 4 Line 65 – 67: each

packet ID is uniquely associated with a particular basic service (Video, Audio, Data) and

any one or more service components of a given basic service can be encrypted prior to

transmission (i.e. partially encrypted)).

As per claim 3 and 15, Wasilewski teaches each of the plurality of digital bit

streams includes a packet identifier, and wherein the selecting step selects the plurality

of digital bit streams by identifying a plurality of predetermined packet identifiers

(Wasilewski: Column 13 Line 65 – Column 14 Line 5 and Column 4 Line 65 – 67: see

the same rationale set forth in rejecting claim 2).

As per claim 4, Wasilewski teaches the selected plurality of digital bit streams are programs (Wasilewski: Column 13 Line 57 – 67 and Column 4 Line 65 – 67: each packet ID is uniquely associated with a particular program / basic service (Video, Audio, Data) and any one or more service components of a given program / basic service can be encrypted prior to transmission (i.e. partially encrypted)).

As per claim 5, Wasilewski teaches the selected plurality of digital bit streams are elementary digital bit streams (Wasilewski: Column 13 Line 57 – 67 and Column 4 Line 65 – 67: each packet ID is uniquely associated with a particular elementary digital bit stream / basic service (Video, Audio, Data) and any one or more service components of a given elementary digital bit stream / basic service can be encrypted prior to transmission (i.e. partially encrypted)).

As per claim 6, Wasilewski teaches a portion of the selected plurality of digital bit streams is encrypted according to the packet identifier associated with each of the plurality of digital bit streams (Wasilewski: Column 13 Line 65 – Column 14 Line 5 and Column 4 Line 65 – 67: each packet ID is uniquely associated with a particular basic service (Video, Audio, Data) and any one or more service components of a given basic service can be encrypted prior to transmission (i.e. partially encrypted) – i.e. any one of the video stream, the audio stream, and the data stream can be included and selected according to its packet ID).

As per claim 7, Wasilewski teaches the packet identifier is indicative of each of the plurality of digital bit streams being one of a video stream, an audio stream, and a data stream (Wasilewski: Column 13 Line 65 – Column 14 Line 5).

As per claim 8 and 16, Wasilewski teaches the encrypted portion includes at least one of the plurality of digital bit streams associated with the video stream (Wasilewski: Column 13 Line 65 – Column 14 Line 5 and Column 4 Line 65 – 67: each packet ID is uniquely associated with a particular basic service (Video, Audio, Data) and any one or more service components of a given basic service can be encrypted prior to transmission (i.e. partially encrypted) – i.e. any one of the video stream, the audio stream, and the data stream can be included and selected and accordingly video stream can be included and selected).

As per claim 9 and 17, Wasilewski teaches the encrypted portion includes at least one of the plurality of digital bit streams associated with the audio stream (Wasilewski: Column 13 Line 65 – Column 14 Line 5 and Column 4 Line 65 – 67: each packet ID is uniquely associated with a particular basic service (Video, Audio, Data) and any one or more service components of a given basic service can be encrypted prior to transmission (i.e. partially encrypted) – i.e. any one of the video stream, the audio stream, and the data stream can be included and selected and accordingly audio stream can be included and selected).

As per claim 10 and 18, Wasilewski teaches the encrypted portion includes at least one of the plurality of digital bit streams associated with the data stream (Wasilewski: Column 13 Line 65 – Column 14 Line 5 and Column 4 Line 65 – 67: each packet ID is uniquely associated with a particular basic service (Video, Audio, Data) and any one or more service components of a given basic service can be encrypted prior to transmission (i.e. partially encrypted) – i.e. any one of the video stream, the audio stream, and the data stream can be included and selected and accordingly data stream can be included and selected).

As per claim 11 and 19, Wasilewski teaches the encrypted portion includes at least one of the plurality of digital bit streams associated with at least one of the video stream, the audio stream, and the data stream (Wasilewski: Column 13 Line 65 – Column 14 Line 5 and Column 4 Line 65 – 67: each packet ID is uniquely associated with a particular basic service (Video, Audio, Data) and any one or more service components of a given basic service can be encrypted prior to transmission (i.e. partially encrypted) – i.e. any one of the video stream, the audio stream, and the data stream can be included and selected).
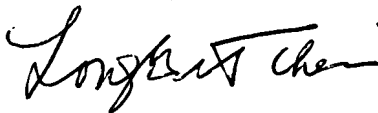
As per claim 12, Wasilewski teaches the portion of the plurality of digital bit streams is encrypted according to a first level encryption method (Wasilewski: Column 4 Line 65 – 67).

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Longbit Chai whose telephone number is 571-272-3788.

The examiner can normally be reached on Monday-Friday 9:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Ayaz R. Sheikh can be reached on 571-272-3795. The fax phone number

for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

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published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

USPTO Customer Service Representative or access to the automated information

system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Longbit Chai, Ph.D.
Patent Examiner
Art Unit 2131
5/8/2007